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EXAMINER
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GARG, YOGESH C

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

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09UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JOEL RONNING and  
KELLY WICAL

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Appeal 2009-1369  
Application 09/492,844  
Technology Center 3600

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Decided:<sup>1</sup> April 20, 2009

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*Before* HUBERT C. LORIN, DAVID B. WALKER, and  
BIBHU R. MOHANTY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

An oral hearing was held on April 7, 2009.

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

## STATEMENT OF THE CASE

Joel Ronning, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1, 3, 8, 14-16, 23, 25, 30, 36-38, 67, and 68. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

## SUMMARY OF DECISION

We REVERSE.<sup>2</sup>

## THE INVENTION

“The present invention relates to an apparatus and method for use in securely downloading files over a network.” Specification 1:18-19.

A method and apparatus consistent with the present invention perform secure downloading of a file from a network upon receiving selection of a file. An order is received from a user for download of the selected file, and the order includes a file identifier related to the file and an order identifier related to the order. The file identifier and order identifier are verified based upon particular information related to the file and order. Download of the file is selectively permitted based upon the verification.

Specification 2:10-15.

Determining whether to accept or decline the order involves the use of accessing information concerning prior attempted purchases using information related to or associated with the

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<sup>2</sup> Our decision will make reference to the Appellants’ Appeal Brief (“App. Br.,” filed Oct. 22, 2007) and Reply Brief (“Reply Br.,” filed Jan. 23, 2008), and the Examiner’s Answer (“Answer,” mailed Nov. 23, 2007).

information in the order, and determining from the related or associated information the likelihood that the order involves a fraudulent attempt to obtain products.

Specification 4:8-12.

Claims 1 and 23, reproduced below, are the sole independent claims and are illustrative of the subject matter on appeal.

1. A method performed by an electronic commerce system having a server and an end user machine interacting through a network for secure downloading of a file from the network, the method comprising the steps of:

- receiving selection of a file via the network;
- receiving an order from a user for download of the selected file via the network, the order including a file identifier related to the file and an order identifier related to the order;

- verifying the file identifier based upon particular information related to the file;

- verifying the order identifier based upon particular information related to the order, including:

- determining if the order identifier is valid for the order, meaning the order identifier exists for the order;

- determining if the order identifier is active, meaning the order was not canceled before the download of the file; and

- determining if the order identifier is non-suppressed, meaning the order was not canceled after the download of the file; and

- selectively permitting the download of the file to the end user machine based upon the verification of the file identifier, the verification of the order identifier, and a number of attempted downloads of the file by the user.

23. An electronic commerce system having a server and an end user machine interacting through a network for secure downloading of a file from the network, comprising:

- a selection module for receiving selection of a file via the network;

- a receive module for receiving an order from a user for download of the selected file via the network, the order including a file identifier related to the file and an order identifier related to the order;

- a file identifier module for verifying the file identifier based upon particular information related to the file;

- an order identifier module for verifying the order identifier based upon particular information related to the order, including:

- a module for determining if the order identifier is valid for the order, meaning the order identifier exists for the order;

- a module for determining if the order identifier is active, meaning the order was not canceled before the download of the file; and

- a module for determining if the order identifier is non-suppressed, meaning the order was not canceled after the download of the file; and

- a download module for selectively permitting the download of the file to the end user machine based upon the verification of the file identifier, the verification of the order identifier, and a number of attempted downloads of the file by the user.

### THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Rogers	US 5,652,786	Jul. 29, 1997
Downs	US 6,226,618 B1	May 1, 2001

The following rejection is before us for review:

1. Claims 1, 3, 8, 14-16, 23, 25, 30, 36-38, 67, and 68 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Downs and Rogers.

### ARGUMENTS

With respect to the subject matter set forth in claims 1 and 23, the Examiner contended that Downs discloses the claimed subject matter and all its limitations except that “Downs does not teach permitting download of the file to the end user machine based on a number of attempted downloads of the file by the user.” Answer 8. Relying on Rogers, the Examiner contended that Rogers disclosed “permitting download of the file based on a number of attempted downloads of the file by the user and a number of successful downloads of the file by the user . . . .” Answer 8. The Examiner found that the combination of Downs and Rogers establishes a prima facie case of obviousness for the claimed subject matter because

[i]n view of Rogers, it would have been obvious to one of an ordinary skill in the art at the time of the invention to have modified Downs to incorporate the feature of permitting download of the file based on a number of attempted downloads of the file by the user and a number of successful downloads of the file by the user. Doing so helps the Downs system to prevent fraudulent use of

debits cards for payments, as explicitly suggested  
[by] Rogers.

Answer 8.

The Appellants challenged the prima facie case of obviousness, arguing, in part, that Downs does not describe or disclose all the limitations of the claimed method and apparatus as the Examiner had contended, notwithstanding that also, as the Examiner agreed, Downs does not disclose “selectively permitting the download of the file to the end user machine based upon ... a number of attempted downloads of the file by the user”

(claim 1). App. Br. 5-8. In particular, according to the Appellants, Downs

fails to describe the feature presently claimed in claims 1 and 23 of verifying the order identifier based upon particular information related to the order, including: (1) determining if the order identifier is valid for the order, meaning the order identifier exists for the order, (2) determining if the order identifier is active, meaning the order was not canceled before the download of the file, and (3) determining if the order identifier is non-suppressed, meaning the order was not canceled after the download of the file.

App. Br. 7. See also Reply Br. 3.

Accordingly, the Appellants challenge the Examiner’s understanding of the scope and content of Downs. *Cf. Muniauction, Inc. v. Thomson Corp.*, 532 F.3d 1318, 1324 (Fed. Cir. 2008) (“The first issue we address with respect to obviousness is the scope and content of the prior art—specifically whether the prior art exhibited every step of the methods claimed in independent claims 1 and 31 of the ’099 patent.”)

The Examiner responded, in part, by arguing that Downs discloses a process by which a

user places an order for downloading a music file[(sic.),] a Transaction SC [secure container] is built containing all the details about the content to [(sic.) be] downloaded, the transaction details, that is [(sic.) are] order details and transaction ID, the usage conditions and is sent to both the user machine 109 and the Clearinghouse 105. Only upon verification of content details [which includes content identifier and description], the transaction ID [order identifier], end-user details, [(sic.), and] usage conditions [(sic.),] the Clearinghouse builds a License SC and sends it to the user machine 109 and only after receipt of this License SC [(sic.), does it] selectively permits [(sic.), permit] the end user device to download the purchased music file to be used as per the usage conditions already agreed.

Answer 11. The Examiner also argued that

Downs further teaches determining if an order identifier is also active-corresponding order must not have been canceled before downloading the ordered file, and non-suppressed -order must not have been canceled after downloading the ordered file, (see Downs at least col. 10, line 50-col. 11, line 27, wherein Downs teaches that the Clearinghouse (s) 105 checks all transactions relating to sale before authorizing license and later checks if the user is permitted to use the authorized license and this corresponds to checking if the order is canceled before and after the order. Also see at least col. 6, line 65-col. 8, line 5, col. 10, lines 19-48, col. 81, line 10-col. 81, line 22, col. 85, lines 53-63.).

Answer 7-8.



## ISSUES

Does Downs describe or disclose the steps of (1) determining if the order identifier is valid for the order, meaning the order identifier exists for the order, (2) determining if the order identifier is active, meaning the order was not canceled before the download of the file, and (3) determining if the order identifier is non-suppressed, meaning the order was not canceled after the download of the file, or modules for doing same, as set forth in claims 1 and 12, and as the Examiner has asserted?

## PRINCIPLES OF LAW

### *Obviousness*

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 17-18.

## ANALYSIS

We have carefully reviewed Downs, including the passages in Downs relied upon by the Examiner, but do not find disclosure of the steps of (1) determining if the order identifier is valid for the order, meaning the order identifier exists for the order, (2) determining if the order identifier is active, meaning the order was not canceled before the download of the file, and (3) determining if the order identifier is non-suppressed, meaning the order was not canceled after the download of the file, or modules for doing the same, as set forth in claims 1 and 12 and as the Examiner has asserted. While Downs would appear to disclose a verification procedure, by itself that does not provide sufficient information to lead one of ordinary skill in the art to conclude that Downs “teaches” the steps of (1) determining if the order identifier is valid for the order, meaning the order identifier exists for the order, (2) determining if the order identifier is active, meaning the order was not canceled before the download of the file, and (3) determining if the order identifier is non-suppressed, meaning the order was not canceled after the download of the file, or modules for doing the same.

The Downs verification procedure appears to involve, via a clearinghouse, steps of obtaining authorization from a content provider and verification that an end-user’s request requests usage complying with content usage conditions. See col. 10, ll. 50-57. If the request is verified, a key for decrypting is provided to decrypt the encrypted content. “If the End-User’s request is not verifiable, complete, or authorized, the Clearinghouse(s) 105 repudiates the request for the decryption key.” Col. 10, ll. 65-67.

We do not see in the verification procedure Downs describes any discussion about determining if the order identifier is valid, active, or non-suppressed, before the download of the file. Accordingly, in order for one of ordinary skill in the art reading Downs to reach the steps of (1) determining if the order identifier is valid for the order, meaning the order identifier exists for the order, (2) determining if the order identifier is active, meaning the order was not canceled before the download of the file, and (3) determining if the order identifier is non-suppressed, meaning the order was not canceled after the download of the file, or modules for doing same, as claimed, the steps/modules would have to necessarily flow from the Downs' verification procedure or have been common knowledge to those with ordinary skill in the art to determine if an order identifier is valid, active, or non-suppressed, before the download of the file, given a verification request. There is no evidence on record of the latter, nor has the Examiner advanced an argument to that effect.

Accordingly, the question boils down to whether the steps/modules at issue would necessarily flow from the Downs disclosure of a verification procedure for obtaining authorization from a content provider and verification that an end-user's request requests usage complies with content usage conditions. In that regard, as the Appellants have suggested (see e.g., App. Br. 7), the steps at issue require the order identifier to be determined to be valid, active, or non-suppressed, before the download of the file. Downs's verification procedure does not require making *any* sort of determination about the status of an order identifier before the download of a file. Therefore, the steps/modules at issue would not necessarily flow from the Downs' verification procedure. As a result, we find that Downs does not

describe or disclose the steps/modules at issue to one of ordinary skill in the art as the Examiner has asserted.

Since Downs does not describe or disclose the steps of (1) determining if the order identifier is valid for the order, meaning the order identifier exists for the order, (2) determining if the order identifier is active, meaning the order was not canceled before the download of the file, and (3) determining if the order identifier is non-suppressed, meaning the order was not canceled after the download of the file, or modules for doing the same, as set forth in claims 1 and 12 and as the Examiner has asserted, the Examiner has not established in the first instance a prima facie case of obviousness for the claimed subject matter over the combination of Downs and Rogers.

#### CONCLUSIONS OF LAW

We conclude that the Appellants have shown that the Examiner erred in rejecting claims 1, 3, 8, 14-16, 23, 25, 30, 36-38, 67, and 68 under 35 U.S.C. § 103(a) as being unpatentable over Downs and Rogers.

#### DECISION

The decision of the Examiner to reject claims 1, 3, 8, 14-16, 23, 25, 30, 36-38, 67, and 68 is reversed.

#### REVERSED

Appeal 2009-1369  
Application 09/492,844

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